

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested.

Claims 1-24 are pending in this application. Claims 1-24 stand rejected.

Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 10, 14-18, 21 and 24 are rejected under 35 U.S.C. §102(b) as being anticipated by **Mori et al.** [US Patent Pub 2001/0013056]. Claims 1, 4-9 and 19-20 are rejected under 35 U.S.C. §102(b) as being anticipated by **Balma et al.** [USP 6,157,945]. Claims 1, 11-12 and 22 are rejected under 35 U.S.C. §102(e) as being anticipated by **Katsikas** [U.S. Patent Pub 2005/0188045]. For the reasons set forth in detail below, these rejections, to the extent they are considered to apply to the currently amended claims, are respectfully traversed.

Initially, it is noted that independent claim 1 has been amended to recite “wherein the means for determining determines whether a prescribed processing condition is satisfied based on a condition of a transmitting side of the electronic mail and a condition of a receiving side of the electronic mail.” Claims 16 and 17 have been amended similarly. Support for this amendment is found, e.g., on page 12, line 12 – page 13, line 8 of the application specification, which describes performing format conversion and the size conversion performed based on information of both sides the communication. For example, as shown in Fig. 5, format conversion is performed based on the domain (or e-mail address) of both the transmitting terminal and the destination.

Mori et al. is directed to an information processor that can send and receive an electronic mail having a large-sized file, such as an image file, attached. More specifically, **Mori et al.** discloses an information processor that compares a size of sent mail with a mail size upper limit value of a destination of the electronic mail. If the size of the sent mail exceeds the mail size upper limit value, the sent mail is divided into a plurality of sub-mail sections. See, e.g., Abstract and paragraph [0009].

Balma discloses a system for routing and forwarding communications, such as electronic mail messages, to a recipient. More specifically, the **Balma** reference discloses a network system used to route communications that can convert the format of the communication.

For example, **Balma** teaches a network office appliance 100 that interfaces a facsimile machine 228 and PC 204 to the Internet 218 or a local area network 208. The network office appliance can convert a facsimile to be sent to a recipient to an electronic mail, and can convert an electronic mail to a facsimile format (see col. 4, lines 29-36 and 47-51). **Balma** also teaches that the network office appliance 100 may scan images and convert the files to any desired format for transmission. See col. 5, line 65 – col. 6, line 5 and col. 6, lines 53-61.

Katsikas discloses a system for eliminating unauthorized electronic mail (i.e., spam) sent to a user on a network. The **Katsikas** system includes an e-mail receiving server 101 (Fig. 1B) connected between a network 103 (Internet) and a user's e-mail client 101 (e.g., Outlook, Netscape). The e-mail server 101 receives e-mails addressed to the user and rejects those for which the sender address does not match any of the sender addresses maintained in an authorized senders list (ASL).

Katsikas also teaches a redirector module that rejects e-mail if the sender's address does not match any authorized sender address found on the ASL list. E-mail rejected by the redirector module is redirected to a Web based messaging module (WBM) that sends a message notifying the sender to confirm that the sender is a legitimate sender of e-mail to the intended recipient.

It is respectfully submitted that none of the cited references disclose or suggest a "wherein the means for determining determines whether a prescribed processing condition is satisfied based on a condition of a transmitting side of the electronic mail and a condition of a receiving side of the electronic mail.," as recited in claim 1 (and similarly in claims 16 and 17).

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 10, 14-18, 21 and 24 are respectfully requested.

The Dependent claims

The dependent claims include additional features that are not disclosed or suggested by the cited references, as discussed below.

Claims 5 and 7

Dependent claims 5 and 7 recite "wherein the specific format is a format which is specific to each electronic mail address or each domain of a destination of the electronic mail." The Examiner cites Fig. 5 of **Balma et al.** to teach this feature (Office Action, page 5, Item 14). However, Fig. 5 teaches designating the format of the storage media and does not teach that a

specific format of an attached file is specific to a mail address or each domain of a destination, as recited in claim 5.

Claims 4 and 6

Dependent claim 4 recites “wherein the prescribed processing condition is when an attached file of the received electronic mail is a specific format” and dependent claim 6 recites “wherein the prescribed processing condition is when an attached file of the received electronic mail is not a specific format.”

However, **Balma** teaches that format conversion of a communication to a recipient is performed either based on a preferred form of communication entered by a recipient, or based on the type of network office appliance at the recipients location. The **Balma** system can apparently convert a format of a communication based on a type of network office appliance at a receiving end (see col. 4, lines 37-61). **Balma et al.** does not disclose or suggest that the format conversion of a communication to a recipient is performed based on when the attached file of an electronic mail is a specific format (claim 4) or is not a specific format (claim 6).

Claim Rejections – 35 U.S.C. § 103

Claims 13 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Mori et al.**, as applied to claims 1-3, 10, 14-18, 21 and 24 above, further in view of Official Notice.

It is submitted that claims 13 and 23 patentably distinguish over the cited prior art for the reasons set forth above by virtue of their dependency on the independent claims.

Application No. 10/633,563
Art Unit: 2154

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 030849

CONCLUSION

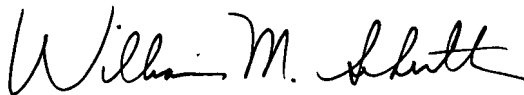
In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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